

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application Number : 10/675,969 Confirmation No. 6294  
Applicant : Hong-Ki KIM et al.  
Filed : October 2, 2003  
Tech Cntr/AU : 2179  
Examiner : Samir Termanini  
Entitled : METHOD, DISPLAY SYSTEM AND COMPUTER SOFTWARE  
FOR CONTROLLING ICON APPEARANCE  
Attorney Reference : 123016-05004702  
Customer Number : 22429

**SECOND PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**

COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria VA 22313-1450

Sir:

This paper is submitted in reply to the Final Office Action mailed October 30, 2009.

Applicants respectfully request review of the final rejections of all claims as manifested in the Final Office Action. No amendments are being filed with this request.

This request is being filed with a **second** Notice of Appeal in compliance with *37 CFR 41.31*. The fee set forth in *37 CFR 41.20(b)(1)* has been paid with the first Notice of Appeal on April 7, 2008.

The review is requested for the reasons stated on the attached sheets.

## REASONS

The following clear errors are found in the Examiner's rejections.

1. This is a second pre-appeal brief request for review. The first one was filed April 7, 2008 and resulted in the withdrawal of all rejections in the final action mailed January 8, 2008. Since then the Examiner has modified the rejections several times; however, *without changing their substance*. Indeed, compared to the final rejections of January 8, 2008 that have been withdrawn as a result of the first pre-appeal brief request for review, the current rejections differ mostly in the Examiner's reliance on *Pham* (instead of withdrawn *Rive*) as allegedly teaching the use of the Windows registry for "storing, securing and protecting properties from loss."

The teaching reference, be it *Rive* or *Pham*, are only relevant (if at all) to where (i.e., the registry) the information is backed-up. The teaching references do teach or suggest the specific claim requirement as to when the information is backed-up which is also missing from the disclosure of *Bogdan*.

Therefore, as to **claims 1-23, 37-38**,<sup>1</sup> the current rejections relying on *Bogdan* and *Pham* are clearly erroneous for the reasons advanced in the first pre-appeal brief request for review dated April 7, 2008, at sections 1.2, 1.3 and 2-5 which are all incorporated by reference herein.

2. As to **independent claim 1**, the current rejection is clearly erroneous for the reasons advanced in the June 11, 2009 Amendment, at page 11, line 4 from bottom through page 13, line 18 which are all incorporated by reference herein.

There are two main points in Applicants' June 11, 2009 arguments. The first point is detailed at page 11, line 4 from bottom through page 12, line 15. The Examiner has not responded

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<sup>1</sup> Note that claims 1-23, 37-38 have not been amended since the first, April 7, 2008 pre-appeal brief request for review.

with reasonable clarity to this point.<sup>2</sup>

The second point is detailed at page 12, line 16 through page 13, line 18. The Examiner has “responded” to this point in the outstanding Final Office Action, at section 10 which is almost a *word-by-word copy of the rejection itself* at page 5, line 4 through page 6, line 7 of the outstanding Final Office Action. While Applicants have put up reasonable efforts to explain Applicants’ position, the Examiner’s rigid and *unexplained* position makes it very difficult for Applicants to properly understand and respond to the Examiner’s rejections.

Since the Examiner’s Response to Arguments is essentially the same as (if not word-by-word copy of) of the rejection itself, Applicants have no choice but to respectfully traverse the Examiner’s Response to Arguments for the same reasons advanced with respect to the rejection. As noted above, Applicants’ arguments have *never* been properly, reasonably responded to by the Examiner.

3. **Independent claims 14 and 23** include features similar to claim 1 and should be considered patentable as well.

It is worthwhile to note *again* that the applied references, especially *Bogdan*, do not teach or suggest changing the appearance of any sample icon in the icon control window in response to user input. The reference only discloses changing the system’s icon appearance after the user has finalized his/her changes. The rejection of claims 14, 23 are clearly erroneous.

4. As to **independent claim 43**, the Examiner rejects claim 43 on the same ground as dependent claim 8.<sup>3</sup> In this rejection, the Examiner alleges how the applied references of *Bogdan* and *Pham* meet every limitation of claim 8, *without at all discussing the limitations of claim 43* which are *very different* from those recited in claim 8.

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<sup>2</sup> See the October 30, 2009 Final Office Action, section 10.

<sup>3</sup> See the October 30, 2009 Final Office Action, at page 8.

The rejection of claim 43 is, therefore, clearly erroneous because the Examiner has failed to properly established a *prima facie* case of obviousness of claim 43 which recites, among other things, “displaying an icon control window on the display screen, the icon control window including a plurality of sample icons having different sizes for a user's preview.” None of the applied references, especially *Bogdan*, teach or suggest the claim feature. Specifically, *Bogdan* discloses a tool for changing the icon's size, but does not teach or suggest multiple sample icons having different sizes in the icon control window as presently claimed. *See*, for example, FIG. 5 of *Bogdan*.

The references, especially *Bogdan*, also fail to teach or suggest the claim limitation of “selecting one sample icon among the sample icons of the icon control window.” What is selected in *Bogdan* is the icon's size (box 82 in FIG. 5) rather than the sample icon itself.

The deficiency of *Bogdan* is not deemed curable by the teaching reference(s), and therefore independent claim 43 is patentable over the applied art of record.

5. The **dependent claims** are considered patentable at least for the reason(s) advanced with respect to the respective independent claim(s).

Withdrawal of the final rejections in view of the above is believed appropriate and therefore respectfully requested.

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To the extent necessary, a petition for an extension of time under *37 C.F.R. 1.136* is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

LOWE HAUPTMAN HAM & BERNER, LLP

/Yoon S Ham/

Yoon S. Ham

Registration No. 45,307

Customer Number: 22429  
1700 Diagonal Road, Suite 300  
Alexandria, Virginia 22314  
(703) 684-1111  
(703) 518-5499 Facsimile  
Date: January 29, 2010  
YSH/KL/jr